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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENZO SCOTTO DI CARLO and EGON SCHULZ

Appeal 2007-3016
Application 09/538,792
Technology Center 2600

Decided: March 25, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and MARC S. HOFF, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-14, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method for notifying a subscriber of a message, which permits a subscriber who is registered with a plurality of message services to be informed of the presence of a new message in a message service (Spec. 2-3). An understanding of the invention can be derived from a reading of independent claim 1, which is reproduced as follows:

1. A method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service;

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services; and

transmitting a notification, with the notification server, to the at least one selected terminal, in contrast to transmitting the message, the transmitted notification indicating that a new message is present and in which message service the new message is present.

The Examiner relies on the following prior art reference:

Smith US 6,333,973 B1 Dec. 25, 2001
(filed Apr. 23, 1997)

The rejections as presented by the Examiner are as follows:

1. Claim 1 stands rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Smith.¹

Rather than repeat the arguments here, we make reference to the Brief (filed July 20, 2005), the Reply Brief (filed September 22, 2006) and the Answer (mailed October 5, 2005) as well as the Supplemental Answer (mailed July 24, 2006) for the respective positions of Appellants and the Examiner.

We affirm.

ISSUES

1. Under the second paragraph of 35 U.S.C. § 112, with respect to appealed claim 1, would the claims reasonably apprise those of skill in the art of their scope?

2. Under 35 U.S.C. § 102(e), with respect to the appealed claims 1-14, does Smith anticipate the claimed subject matter by teaching all of the claimed limitations?

PRINCIPLES OF LAW

Indefiniteness

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area

¹ In a Supplemental Examiner's Answer (mailed July 24, 2006), the Examiner includes claims 13 and 14 in the rejection, which were inadvertently omitted from the statement of the rejection in the Final Office Action.

with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977), *citing In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). “The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (*citing Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991), *Genetics Inst., Inc. v. Amgen, Inc.*, 112 S. Ct. 169 (1991)). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. *See In re Hyatt*, 708 F.2d 712, 715 (Fed. Cir. 1983).

Anticipation

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *See In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (*citing Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

Affidavit or declaration of prior invention

37 C.F.R. § 1.131(b) requires that showing priority of invention may be done by any satisfactory evidence of the fact:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

ANALYSIS

1. 35 U.S.C. § 112, second paragraph, rejection

The Examiner takes the position that the language used to refer to the “message” and the “new message,” as recited in claim 1, for which a notification is transmitted to notify its presence is inconsistent and renders the claims indefinite (Supp. Ans. 11). Appellants contend that a reasonable reading of claim 1 would make it apparent that “the message” recited in line 13 of the claim refers to “the new message” (App. Br. 25-26). In an attempt to make the claimed language consistent, Appellants have proposed amending claim 1 to include the term “new,” which was not entered by the Examiner.²

After reviewing the Specification, we find that the notification is transmitted in order to inform the user of the presence of a new message

² We do not need to determine the propriety of the Examiner’s refusal to enter the amendment to the claim since it is not an appealable issue and is not before this panel.

(e.g., Specification 10:6-10, 11:15-19). Furthermore, the term “the message,” as understood by one of ordinary skill in the art, could only refer to “a new message” recited in line 4 of the claim. As such, since the claimed terms “a new message” and “the message,” as used in the claim language, are clear and reasonably apprise those of skill in the art of the scope of claim 1, the rejection of claim 1 as being indefinite under the second paragraph of 35 U.S.C. § 112 is not sustained.

2. *35 U.S.C. § 102(e) rejection*

Appellants do not dispute the Examiner’s findings with respect to Smith as to how the reference discloses the claimed subject matter recited in Appellants’ claim 1. Appellants’ contentions focus on whether Smith is available as prior art in rejecting the instant claims (Br. 14) and rely on a declaration under 37 C.F.R. § 1.131, which was signed by both inventors to show that the invention was reduced to practice prior to April 23, 1997, which is the filing date of Smith. As the corroborating evidence in support the facts stated in their declaration (filed December 6, 2002), Appellants provided an invention disclosure document dated April 24, 1997 to show reduction to practice and later provided a separate declaration, filed December 23, 2004, to state that the invention was conceived at least as early as April 22, 1997.

Before addressing the merits of the declarations and whether they are successful in removing Smith as prior art, we acknowledge Appellants’ frustration (Br. 16-22) with the Examiner’s change of position in using a

different reference in place of Smith (which coincided with the filing of the declaration), apparently without clarifying the reason for doing so, and failing to articulate whether Appellants' declaration had been considered and deemed effective in overcoming the rejection. However, explaining the reasons for those specific courses of action is not within the jurisdiction of the Board or a function of this panel. While not common, using a previously applied reference in rejecting claims during prosecution is permissible, which may occur upon further review of the record. Additionally, since the prosecution was not closed, using previously applied prior art was not precluded.

In response to Appellants' arguments regarding the effectiveness of the § 131 Declaration, the Examiner maintains that the declaration is not effective since merely alleging in the second declaration that conception was prior to that date is not sufficient (Supp. Ans. 7). The Examiner asserts that the evidence provided by Appellants, at best, establishes reduction to practice on April 24, 1997, which is after the effective date of Smith (*id.*). The Examiner further relies on the requirements for showing prior invention, as outlined in MPEP § 715, and argues that the declaration is not effective because Appellants provided no evidence in support of their statement with respect to the date the invention was conceived (Supp. Ans. 9).

Based on our review of Smith and the evidence Appellants provided in support of the § 131 declaration, we agree with the Examiner that a mere statement by Appellants that conception took place prior to a particular date is not sufficient to show prior invention. In that regard, MPEP § 715.07 [R-

3] - Facts and Documentary Evidence provides the general requirements of a declaration made under 37 C.F.R. § 1.131 as follows:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Here, Appellants' declaration of 2004 merely states that the invention was conceived at least as early as April 22, 1997. We agree with the Examiner that the declaration is ineffective since it lacks the proper statement of facts and the relevant exhibits, such as drawings and records, to show that the invention was conceived prior to April 22, 1997.

Appellants further argue that the document labeled "MWI server patent proposal" submitted with the Invention Disclosure and dated April 24, 1997 possesses such levels of detail that, by itself, demonstrates preparation at a prior date and therefore, conception before the effective date of Smith (Suppl. Reply Br. 7-8). Although Appellants' explanations appear

to be plausible, we find the § 131 declaration to be lacking a clear explanation in the form of a statement of facts, accompanied by the exhibits and records, corroborating Appellants' statement alleging the date the invention was conceived. As stated by Appellants, a document such as the MWI, mentioned *supra*, is of such complexity that was probably developed based on prior preparations, which are usually preserved in the form of notes, outlines, or initial drafts. Alternatively, Appellants' statement of facts may rely on circumstances in which the invention was conceived, such as, but not limited to, discussions or communications with others. See MPEP § 715. Appellants have provided neither.

In view of the above discussions, since Appellants' declaration under 37 C.F.R. § 1.131 is not effective to show prior invention, Smith is available as prior art. Accordingly, the Examiner's 35 U.S.C. § 102(e) rejection of claims 1-14 is sustained.

CONCLUSION

On the record before us and in view of our analysis above, we have not sustained the 35 U.S.C. § 112, second paragraph, rejection of claim 1. However, we have sustained the 35 U.S.C. § 102(e) rejection of claims 1-14. Therefore, the Examiner's decision rejecting claims 1-14 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-3016
Application 09/538,792

AFFIRMED

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